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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/429,047 | 10/29/1999 | JAMES V. LUCIANI | 082771.P259 | 5463 |

7590 11/06/2002

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EXAMINER

HA, YVONNE QUY M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2697

DATE MAILED: 11/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Xm

Office Action Summary

Application No.

09/429,047

Applicant(s)

LUCIANI, JAMES V.

Examiner

Yvonne Q. Ha

Art Unit

2697

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/29/99 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: References 110, 115, 120, 105, 100 in Figure 3. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-5, 6, 7, 9, 10, 11, 14, 15, 19, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Chiang et al., US Patent 5,835,725.

Referring to claims 1, 14, and 19, Chiang et al. disclosed the end station initiates the session by issuing a novel address assignment request to the intermediate station (col. 5, lines 1-12). The destination initiates the session by issuing a novel address assignment request to the router (server). The router responds to the request by assigning the end station an address chosen from a pool of addresses allocated to the router. If the assigned address is unacceptable, the end station reissues the address assignment request to which the router reallocates another address from the pool (col. 7, lines 63-69). The source and destination path is defined once the connection is established (col. 3, lines 3-7).

Referring to claims 2-5, Chiang et al. disclosed all aspects of the claimed invention and further taught the NHRP capability of source and server (an address resolution protocol technique enables an intermediate station (router) to dynamically assign and address to end station, (col. 7, lines 49-53) and the forwarding and response from server to destination (destination request address assignment and the router response to the request, col. 7, lines 63-67). The source and destination path is defined once the connection is established (col. 3, lines 3-7).

Referring to claims 6 and 11, Chiang et al. disclosed the determination of the internetwork layer address and subnetwork layer address between the router and the destination (col. 7, lines 14-22). When the layer receives a packet from the transport layer for transmission over the network, it encapsulates the packet with a header containing, inter alia, source and destination IP addresses (col. 7, lines 11-22).

Referring to claims 7, 9, and 10, Chiang et al. disclosed all aspects of the claimed invention and further taught the determination of the internetwork layer address and subnetwork

layer address between the router and the destination (col. 7, lines 14-22) where the router decapsulates the packet and transmitted over to the end station. In addition, Chiang et al. disclosed the resolution request and response between the server and destination (In response to the request, the router assigns the client an address chosen from a pool of addresses allocated to the router. If the assigned address is unacceptable, the client reissues the address assignment request to which the router reallocates another address from the pool (col. 7, lines 63-67).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 8, 12, 13, 16, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chiang et al. US Patent 5,835,725 in view of Reed et al. US Patent 6,061,739.

Referring to claim 8, Chiang et al. disclosed all the aspects of the claimed invention and further taught that the address acknowledgement of receipt and acceptance by returning a response cap-xchange message with the field set to the null "s value" is sent over to server (col. 9, lines 48-50 of Chiang). Chiang et al. failed to explicitly disclose time/length/value that server recognized. However, Reed et al. disclosed when the device monitor sees a preset threshold unanswered ARP requests in a given length of time, the device adopts the requested network address and responds to the ARP with its hardware address (col.4, lines 27-30 of Reed). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to specify the time stamp and limits in the registration request because the time stamp would be

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used as an indicator for the system to flag any unanswered message and proceed on with the next message treatment.

Referring to claim 12, Chiang et al. disclosed all aspects of the claimed invention and further taught the client examines the assigned address to determine if it is acceptable. The client acknowledges receipt and acceptance of that address by returning a response cap-xchange message with the assigned address (col. 9, lines 45-50 of Chiang). The Chiang et al. reference failed to explicitly disclose the rejection or acceptance of resolution request based on management signaling. However, the Reed et al. reference disclosed the steps of generating the ARP (Address Resolution Packets) by attempting a connection to the network from the device and the steps of dropping the adopted network address when the attempt connection to the network fails in a given length of time (col. 6, line 48-54 of Reed). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to base on management signaling because it is conventional for this type of signaling message to carry information such as resource availability, address allocation.

Referring to claim 13, Chiang et al. disclosed all aspects of the claimed invention and further taught the four layers are formed to a protocol stack (ie, network, internetwork, transport, and application). The application layer provides services for different types of applications such as terminal connection, electronic mail, Simple Mail Transfer Protocol and the File Transfer Protocol (col. 2, lines 7-11 of Chiang et al.). The Chiang et al. reference failed to explicitly disclose the rejection or acceptance of resolution request based user configuration. However, Reed et al. disclosed the servers and clients may comprise any device capable of being connected to a network (ie, inter alia, processor, RAM, data storage devices, data communications, monitor,

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user input devices (col. 4, lines 55-59). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to base on user configuration because it is conventional to have user profile and preference from a source request such as application type, connection type, hardware type.

Referring to claims 16, 17, and, 18, Chiang et al. disclosed an intermediate station of a heterogeneous network to dynamically assign an address to an end station. Chiang et al. failed to explicitly disclose of forwarding resolution request about the internetwork layer to subnetwork layer addresses to one of the destinations based on arbitration scheme. However, Reed et al. disclosed monitoring communication on the network to observe unanswered address resolution protocol packets (col. 6, lines 31-33 of Reed). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to forwarding resolution request about the internetwork layer to subnetwork layer addresses to one of the destinations based on arbitration scheme. As Chiang et al. disclosed the dynamic address assignment and Reed et al. disclosed the monitoring of unanswered address, it is conventional to arbitrarily select the appropriate destination when there are plurality destinations in the configuration, especially for load balancing and resource efficiency.

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Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure

- Chiang et al. US Patent 5,835,725 disclosed the dynamic address assignment and resolution technique.
- Reed et al. US Patent 6,061,739 disclosed the network address assignment using physical address resolution protocols

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yvonne Q. Ha whose telephone number is 703-305-8392. The examiner can normally be reached on Mon-Fri. 7:00 a.m.- 4:00p.m. Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffery Hoffsass can be reached on 703-305-4717. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3988 for regular communications and 703-305-9051 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

YQH
November 1, 2002


RICKY NGO
PRIMARY EXAMINER